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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Frederic Greenbaum

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PROSKAUER ROSE LLP

PATENT DEPARTMENT

1585 BROADWAY

NEW YORK, NY 10036-8299

EXAMINER

MAGUIRE, LINDSAY M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/090,285	Applicant(s) GREENBAUM ET AL.	
	Examiner LINDSAY M. MAGUIRE	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-18 and 20-52 is/are pending in the application.
- 4a) Of the above claim(s) 37-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-36, 51 and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Non-Final office action is in response to the application filed on March 4, 2002, the response to the Election/Restriction requirement filed on May 15, 2007, the amendments filed on December 4, 2007, and the Request for Continued Examination filed on September 29, 2008.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-36 and 52 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A 35 USC 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. To qualify as a 35 USC 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps. Since that requirement is not met by the claims, the method is not a patentable eligible process under 35 USC 101 and is rejected as being directed to non-statutory matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-18, 20-36, 51, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. PG Pub. No. 2002/0059107 (Reich et al. '107), in view of "Insider Trading, Prohibition of Securities and Exchange Board of India Regulations, 1992" (Regulations, 1992).

Reich et al. '107 disclose a system for implementing a compliance program in a financial institution, comprising: a list data base (Figures 2-3; paragraph [0029]); a list manager, said list manager receiving a compliance query from an affiliate of the financial institution having a stats, said list manager providing a compliance response to said affiliate based on said plurality of entities and according to said status of said affiliate based on said plurality of entities and according to said status of said affiliate (paragraph [0026]).

Reich et al. '107 disclose the system substantially as claimed with the exception of requiring that said material information regarding the plurality of entities is partitioned into a Grey list and a Restricted list. Regulations 1992 disclose that, "in order to monitor chinese wall procedures and trading in client securities based on inside information, the

organization/firm shall restrict trading in certain securities and designate such list as a restricted/grey list" (Section 4.0). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reich et al. '107 in view of Regulations 1992 for the basic reason of monitoring the chinese wall, and to comply with all regulations in regards to insider trading laws.

Additionally Reich et al. '107, in view of Regulations 1992, disclose that wherein said affiliate is an employee (paragraph [0024], lines 5-7), said compliance query is requested by said employee to trade a security of an entity and said compliance response is a denial of said request to trade if said entity is included in the partition of said plurality of entities included in said Restricted list (paragraphs [0024-0034]); wherein said affiliate is a trader (paragraph [0024], lines 5-7; it is noted that the term "other party" is considered by the examiner to include 'a trader'), said compliance request is a request to trade a security of an entity and said compliance request includes at least one of said plurality of entities included in said Restricted list and a clearance code (paragraphs [0034-0035]); and wherein associated with said at least one of said plurality of entities is a transaction type and said request to trade has an activity type and wherein said clearance code denies said request to trade on said transaction type and said activity type (paragraph [0035]).

Furthermore, Reich et al. '107, in view of Regulations 1992, disclose that said transaction type includes mergers and tender offers (paragraph [0034]); wherein said

activity type includes derivative trading activity (paragraph [0037]); wherein said affiliate is a supervisory analyst (paragraph [0024], lines 5-7; it is noted that the term “other party” is considered by the examiner to include ‘a supervisory analyst’), said compliance request is a request to issue a report regarding an entity and said compliance response includes at least one of said plurality of entities included in a combination of said Restricted list and said Grey list (Regulations 1992, section 4.0); wherein said compliance response includes at least one safe harbor provision that grants at least a portion of said compliance request (paragraph [0044]); wherein said grant of said portion of said compliance request is based on geography (paragraph [0030]); wherein said affiliate is a compliance officer (paragraph [0024], lines 5-7; it is noted that the term “other party” is considered by the examiner to include ‘a compliance officer’), said compliance request is a request to view at least a portion of a combination of said Restricted list and said Grey list and said compliance response includes said portion of the combination of said restricted list and said grey list (paragraphs [0033-0057]); wherein said compliance response includes for at least one of said plurality of entities included in said portion a clearance code and a transaction type (paragraph [0035]); and wherein said compliance response includes for at least one of said plurality of entities included in said portion a safe harbor provision (paragraph [0044]).

Reich et al. ‘107, in view of Regulations 1992, also disclose a surveillance system wherein said surveillance system receives said plurality of entities stored in said list database for monitoring trading activity in accordance with said compliance program

(paragraph [0048]); wherein said list database receives said plurality of entities from a compliance officer in communications with said system (paragraph [0024], lines 5-7; it is noted that the term “other party” is considered by the examiner to include ‘a compliance officer’); wherein said list database receives at least a portion of said plurality of entities from a transaction information source (paragraph [0024]); wherein said list database receives positional information relating to said financial institution and wherein said compliance response is based on said positional information (paragraph [0030]); and wherein said list database receives affiliate directorship information and wherein said compliance response is based on said on said affiliate directorship information (paragraphs [0024-0036]).

It is noted that claims 20-36 are considered to be substantially similar to claims 2-18. Any argument to the contrary must include additional arguments as to why these claims are considered to be distinct from claims 2-18, yet similar enough as to not warrant further restriction of the claims.

Regarding claim 51, Reich et al. '107 disclose a system for implementing a compliance program in a financial institution, comprising: a list database (Figures 2-3; paragraph [0029]) that stores material information regarding a plurality of entities that are known to the financial institution, and a list manager that receives a compliance query from an affiliate of the financial institution (paragraph [0026]), the list manager configured to respond to the compliance query by retrieving and displaying the

information stored in the list database that is responsive to the compliance query (paragraph [0027, 0054, & 0060], Figure 5).

Reich et al. '107 disclose the system substantially as claimed with the exception of requiring that said material information regarding the plurality of entities is partitioned into a Grey list and a Restricted list. Regulations 1992 disclose that, "in order to monitor chinese wall procedures and trading in client securities based on inside information, the organization/firm shall restrict trading in certain securities and designate such list as a restricted/grey list" (Section 4.0). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reich et al. '107 in view of Regulations 1992 for the basic reason of monitoring the chinese wall, and to comply with all regulations in regards to insider trading laws.

In regards to claim 52, Reich et al. '107 disclose a method for implementing a compliance program in a financial institution, comprising: storing a plurality of entities in a list database (Figures 2-3; paragraph [0029]), the financial institution being associated with each of said plurality of entities; receiving a compliance query from an affiliate of the financial institution (paragraph [0026]); and responding to the compliance query with restriction information stored in the list database that is responsive to the compliance query (Figure 5, paragraphs [0027, 0054, & 0060]).

Reich et al. '107 disclose the system substantially as claimed with the exception of requiring that said material information regarding the plurality of entities is partitioned into a Grey list and a Restricted list. Regulations 1992 disclose that, "in order to monitor chinese wall procedures and trading in client securities based on inside information, the organization/firm shall restrict trading in certain securities and designate such list as a restricted/grey list" (Section 4.0). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reich et al. '107 in view of Regulations 1992 for the basic reason of monitoring the chinese wall, and to comply with all regulations in regards to insider trading laws.

Response to Arguments

Applicant's arguments with respect to claims 2-18, 20-36, 51, and 52 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. However, applicant's provisional application does not fully support the limitations of a clearance code or an activity type, and therefore priority for those limitations is limited to the actual filing date of the application and not the filing date of the provisional application.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view

of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Conclusion

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts of disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSAY M. MAGUIRE whose telephone number is (571)272-6039. The examiner can normally be reached on M-F: 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3692

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lindsay M. Maguire
10/9/08
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Examiner, Art Unit 3692

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